BEFORE THE U.S. PATENT AND TRADEMARK OFFICE

In re: Small Business Study
of Trademark Litigation Tactics

Comments of Barbara L. (Pixie) Waite

I am an attorney with an office located at 1425 K Street N.W., Suite 350, Washington, DC 20005. I am admitted to the bars of the District of Columbia and of the State of New York. I have been practicing law for some twenty-six years.[1]

I have been involved in two cases of what I consider to be egregious instances of "trademark bullying". Both involved plaintiffs who were large international corporations and defendants who were small Canadian companies.

The first instance was *Toyota Jidosha Kabushiki Kaisha et al. v. Aliments Lexus Inc. et al.*, 02-CV-0013 (E.D.N.Y.). Lexus Foods was a tiny producer and distributor of fruit juices located in Rougemont, Quebec. It applied to register its trademark, LEXUS, for fruit juices on the Canadian trademark registry, and Toyota opposed the application on the basis of its LEXUS brand for luxury automobiles. Toyota pursued the matter to the highest Canadian court, over a period of some eight years, but Lexus Foods prevailed, achieving a registration.

In the meantime, Lexus Foods had been distributing its LEXUS brand fruit juices both in Canada and in the United States. Believing that Toyota objected only to its registration of the LEXUS brand name, as it had never made demand upon Lexus Foods to cease using its mark, Lexus Foods did not apply to register its trademark in the United States.

While the registration of the mark was still at issue in Canada, Toyota learned that Lexus Foods was using the mark in the United States[2] and sent a cease-and-desist letter. Lexus Foods declined Toyota's demand. Approximately one year later, after losing its case in Canada, Toyota

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[1] I opened my own office in October of 2008. Prior to that time, since 1984, I was practicing with the Venable firm, also of Washington, DC. My practice includes prosecution, advice, and litigation regarding trademarks and copyrights and the related fields of advertising law and business torts.

[2] Toyota had long known that Lexus Foods was using the mark in Canada. It was never established when Toyota knew, or should have known, that the mark was in use in the U.S. by Lexus Foods.

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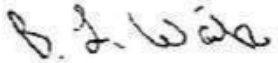
Respectfully submitted,



Barbara L. (Pixie) Waite